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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,642	05/30/2001	Ilia Zverev	IFT774US	8001

24131 7590 11/30/2004
LERNER AND GREENBERG, PA
P O BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER

JONES, HUGH M

ART UNIT PAPER NUMBER

2128

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,642

Applicant(s)

ZVEREV ET AL.

Examiner

Hugh Jones

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/30/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Claims 1-5 of U.S. Application 09/867,642, filed 05/30/2001 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. There is no disclosed enabling detail relating to the catalogue, the standalone simulator, its implementation or its integration into the claimed invention in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification appears to merely disclose generalities.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

6. A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ishigami et al.

8. Ishigami et al. disclose that it was known in the art (as of at least 12/27/2001) for a vendor to download to a customer a simulation program after an order is placed. See line 24, col. 1 to line 8, col. 2. See *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994).

8. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Beall et al. or McDonald et al..

9. Beall et al. disclose downloadable applets for simulation of circuit components which may be purchased from a vendor (See line 56, col. 15 to line 32, col. 16):

"The information for a part might also be marked as having additional information associated with it on the World Wide Web. For example, the complete data sheet for a part, including all specifications, usage notes, and characteristics information, may be available as an HTML document, with its Universal Resource Locator ("URL") associated with the parts as one of its parameters. If an instance is selected and it has a URL associated with it, a "hot links" button 4075 will become active. The user may click on the hot links button 4075 to cause the browser 4014 to retrieve the HTML document, or download an applet in the form of executable content (for example, a circuit simulation applet to model the selected integrated circuit's performance). The user may choose to browse this associated information by choosing to view linked data, resulting in the launch of an instance of a Web browser with the URL. URLs may also be associated with any

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class, attribute, or standard attribute value within the knowledge base 4012. For example, a URL for an HTML document describing all of National Semiconductor's plastic integrated circuit package types could be associated with an enumerator for the attribute package type 4071. Selecting the option to view this linked data would launch the Web browser 4014 beginning at the URL, allowing the plastic package application notes to be viewed. Any of these associated URLs might also be Java applets, whose launch results in execution of the applet locally within the users Web browser 4014. For example, an output voltage attribute might have an associated HTML page containing an applet that interacts with the user, accepting various input parameters and dynamically graphing the resulting voltage or current curves representing device characteristics. This allows for interactive functionality associated with any database element to be delivered to the user on demand.

Finally, the user may decide to order a sample of a part. The user would choose an "order sample" link associated with the information displayed for a part, and an applet would run in the browser allowing the user to specify quantity desired, intended use, ordering and billing information. This information would be communicated using an executable content based remote procedure call mechanism to an application at National Semiconductor that would automatically verify and place the order for the user. An executable content based remote procedure call mechanism will be described in more detail below."

10. McDonald et al. disclose an electronic catalogue (lines 18-49) and a downloadable simulation package (lines 20-64, col. 8).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be:

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directed to:

Dr. Hugh Jones telephone number (571) 272-3781, Monday-Thursday 0830 to 0700 ET,

or

the examiner's supervisor, Jean Homere, telephone number (571) 272-3780.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

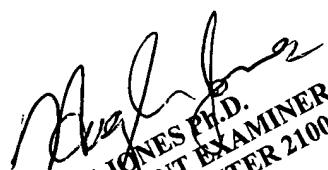
(703) 308-9051 (for formal communications intended for entry) **or**

(703) 308-1396 (for informal or draft communications, please label "*PROPOSED*" or "*DRAFT*").

Dr. Hugh Jones

Primary Patent Examiner

November 20, 2004


HUGH JONES PH.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100